

#5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Gek-Kee Sim et al.

Serial No.: 09/646,561

Filing Date: September 19, 2000

International Filing Date: March 19, 1999

For: T CELL COSTIMULATORY PROTEINS,
SEQUENCES AND USES THEREOF

Attorney Docket No.: HKZ-029CPUS

Group Art Unit:

Examiner:

RECEIVED

14 FEB 2001

Legal Staff
International DivisionCommissioner for Patents
Box PCT (EO/DO/US)
Washington, D.C. 20231PETITION PURSUANT TO 37 CFR § 1.47(a)

Dear Sir:

Applicants hereby petition, pursuant to 37 CFR § 1.47(a), for acceptance of the enclosed Declaration for Patent Application when one of the co-inventors, Gek-Kee Sim, refuses to sign or cannot be reached. In support of this Petition pursuant to 37 CFR § 1.47(a), enclosed is a Declaration of Susan A. Gordon setting forth the pertinent facts and the fee set forth in 37 CFR § 1.17(h) of \$130.00. As disclosed in the attached Declaration and accompanying documentary evidence, diligent efforts have been made to present a copy of the application papers to the non-signing inventor, Dr. Sim. Despite twice sending copies of a Declaration and Assignment to Dr. Sim's last known address, Applicants have received no response. Accordingly, Applicants conclude that Dr. Sim either refuses to sign or cannot be reached.

02/06/2001 LLANDRA 00000005 09646561

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130.00 OP

Respectfully submitted,

"Express Mail" mailing label number EL 373208543 USDate of Deposit February 1, 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents, Box PCT (DO/EO/US), Washington, DC 20231

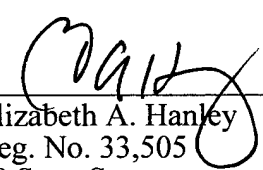
Signature

Viriato G. Cardoso

Please Print Name of Person Signing

LAHIVE & COCKFIELD, LLP
Attorneys at Law

By


Elizabeth A. Hanley
Reg. No. 33,505
28 State Street
Boston, MA 02109
617-227-7400Date: February 1, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

Sim, Gek-Kee
 Yang, Shumin
 Sellins, Karen S.

) Group Art Unit:

)

) Examiner:

)

)

DECLARATION OF
SUSAN A. GORDON

)

Serial No.: 09/646,561

)

)

Filed: September 19, 2000

)

)

Atty. File No.: HKZ-029CPUS

)

)

For: "T CELL COSTIMULATORY PROTEINS,
 SEQUENCES AND USES THEREOF"

)

Assistant Commissioner for Patents
 Washington, DC 20231

Dear Sir:

I, Susan A. Gordon, have firsthand knowledge of the facts set forth in paragraphs 1-7 below.

1. Gek-Kee Sim is a joint inventor of the above-identified patent application and a former employee of Heska Corporation.

2. Dr. Sim was an employee at Heska Corporation from February 1, 1996 through August 25, 1998. The last known official address provided by Dr. Sim that Heska Corporation has on file is 3622 Terry Point Drive, Fort Collins, CO 80524.

3. On July 23, 1999, I met with Dr. Sim at the Starbuck's on Drake Avenue in Fort Collins, CO to get her signature on patent documents unrelated to the present application. Dr. Sim informed me that she was putting her 3622 Terry Point Drive, Fort Collins, CO 80524 residence up for sale, and planned to move to the house of her acquaintance Dr. Andre Augustine.

4. In March of 2000, I called the Fort Collins Post Office and spoke with Steve O'Connell asking if Dr. Sim had left forwarding address information. Mr. O'Connell said that mail addressed to Dr. Sim at 3622 Terry Point Drive, Fort Collins, CO 80524 is not forwarded. Dr. Sim is no longer at that address and left no forwarding order.

5. On April 5, 2000, I sent a letter signed by Carol Talkington Verser (patent agent for the above-referenced patent application) addressed to Dr. Sim, c/o 543 Franklin Street, Denver, Colorado 80218-3623, asking for her review and signature of a manuscript. Dr. Sim signed the enclosure to that letter, "Heska Technical Presentation Approval Form", and returned it with a note. Copies of the letter, Dr. Sim's signature on the approval form and Dr. Sim's note, along with the envelope in which she returned them, are attached as Exhibit A. Please note that the return address on the envelope used by Dr. Sim indicates that Dr. Sim is now using 543 Franklin Street, Denver, CO as her return address.

6. On November 8, 2000, I sent a letter by Federal Express to Dr. Sim at 543 Franklin Street, Denver, Colorado (which is the address of her known acquaintance, Dr. Andre Augustine), enclosing a Declaration and Assignment for the above-referenced patent application and requesting that she sign the documents and return them to Heska in the return Federal Express envelope provided. To date, I have not received the documents. A copy of the letter and Federal Express report are attached as Exhibit B.


7. On December 22, 2000, I sent a another letter by Certified Mail on behalf of Carol Talkington Verser, Ph.D. to Dr. Sim at 543 Franklin Street, Denver, Colorado, enclosing another copy of the Declaration and Assignment for the above-referenced patent application requesting that she sign the documents and return them to Dr. Verser in the return FedEx package provided. To date we have not received the signed documents, nor have we received the Certified letter return receipt requested. A copy of the Certified letter is attached as Exhibit C.

I have called the claims office of U.S. Post Office Capitol Hill Station in Denver, Colorado, asking for information on the Certified letter, but they have been unsuccessful in tracing the letter. Their policy is to leave the addressee a first notice of the Certified letter. When the Certified letter is unclaimed, the mail carrier delivers a second notice five days after the first notice. The post office cannot trace the letter until it has been at least 21 days since the date of the first notice. I continue to call the post office weekly, but as of January 26, 2001, they still have no tracing information on the Certified letter.

I hereby declare that all statements made herein of my own are true and that statements made on information and belief are believed to be true; and further that the statements were made

with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the subject application or any patent issuing therefrom.

Dated: January 26, 2000



Susan A. Gordon
Senior Administrator, Intellectual Property to
Carol Talkington Verser, Ph.D. (Reg. No. 37,459)
Heska Corporation
1613 Prospect Parkway
Fort Collins, Colorado 80525
Telephone: (970) 493-7272
Facsimile: (970) 491-9976

I hereby declare that the attached "EMPLOYEE CONFIDENTIAL INFORMATION AND INVENTIONS AGREEMENT" is a true copy of the agreement signed by Gek-Kee Sim governing her employment at Heska Corporation from February 1, 1996 through August 25, 1998, which assigns all right, title and interest in all Inventions made by Gek-Kee Sim, as defined in Section 2 of the Agreement, to Heska Corporation.

By: Mirosława Saraullo
Name: Mirosława Saraullo
Title: HR Representative

STATE OF COLORADO)
) ss.
COUNTY OF LARIMER)

2001 Before me, a Notary Public in and for said county and state, on this 26th day of ~~April~~ January ~~1999~~, personally appeared Mirosława Saraullo, as HR Representative of Heska Corporation, 1613 Prospect Parkway, Fort Collins, Colorado, known to me to be the person whose name is subscribed to the foregoing instrument.

Susan A. Gordon
Notary Public

My commission expires: Nov. 22, 2004.



COPY

**EMPLOYEE CONFIDENTIAL INFORMATION
AND INVENTIONS AGREEMENT**

THIS AGREEMENT is between Heska Corporation a California corporation (the "Company"), and GekKee Sim (Employee").

PURPOSE OF THE AGREEMENT

I wish to be employed by, or continued in the employment of, the Company, and the Company wishes to employ me, or continue to employ me, provided that, in so doing, it can protect its trade secrets and inventions, ideas, information, business, and good will.

In consideration of this purpose, and the mutual promises in this Agreement, I agree with the Company as follows:

1. Confidential Information. I will hold in confidence during the entire term of my employment and for five years after the termination of my employment all Confidential Information of the Company and all Confidential Information of companies or persons other than the Company given to the Company under an agreement prohibiting its disclosure. "Confidential Information" refers to valuable technical or business information that is not known by the public. By way of example, Confidential Information may include information relating to: inventions or products, including unannounced products; research and development activities; requirements and specifications of specific customers and potential customers; nonpublic financial information; and quotations or proposals given to customers.

These restrictions on disclosure do not apply if (i) the information is or becomes publicly known through no wrongful act or part; (ii) I already knew the information prior to the time I began employment with the Company, other than by disclosure to me by the Company; (iii) I received the information without any wrong doing from someone outside the Company who does not have an obligation to keep the information confidential; (iv) the information is explicitly approved for release by an officer of the Company; or (v) the information is disclosed pursuant to the requirement of a governmental agency.

(2) Disclosure and Assignment of Inventions. I will promptly disclose and assign to the Company my entire right, title and interest in all Inventions. "Inventions" refers to (a) all technical or business innovations, whether or not patentable or copyrightable, made by me during the term of my employment; and (b) all technical or business innovations, whether or not patentable or copyrightable, based upon the Company's Confidential Information and made by me after leaving the Company's employment. I will keep adequate written records of all Inventions made by me, such as notebooks, sketches, program listings and the like, which are the property of the Company. Notwithstanding the foregoing, I am not required to assign to the Company, although I must disclose, any invention: (a) for which no equipment, supplies, facilities or Confidential Information of the Company were used and which was developed entirely on my own time; (b) which at the time of conception or reduction to practice did not relate directly to the business of the Company or the Company's actual or demonstrably anticipated research or development; and (c) which did not result from any work I performed for the Company. The disclosure of such inventions must be made so that the parties can make a determination whether such inventions do in fact qualify for exclusion from assignment to the Company. The Company will keep confidential any such information I disclose. I will take all steps necessary to assist the Company in securing any patents, copyrights, or other protection for Inventions which I am required to assign to the Company as provided above. If I am unable or unwilling, whether during my employment or after termination, to sign any papers needed to apply for or pursue any patent or

copyright registrations for Inventions, I agree that the Company is my attorney-in-fact for that purpose and can sign such papers as my agent and take any other actions necessary to pursue these registrations.

3. Tangible Materials. All tangible materials that incorporate Confidential Information are the Company's property, and I will give all these materials back to the Company at the termination of my employment or earlier upon the Company's request.

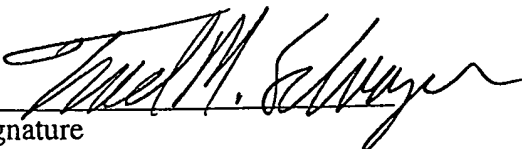
4. Duties to Third Parties. I represent that, to the best of my knowledge, compliance with the terms of this Agreement will not violate any duty that I may have to anyone other than the Company (such as a former employer) to keep such person's proprietary information in confidence or to refrain from using that person's patents or copyrights. If at any time during my employment with the Company, I am asked by the Company to perform work which I believe may cause me to violate a duty I have to someone other than the Company, I will immediately inform an officer of the Company so that an assessment of the situation may be made. I also agree that I will not, during my employment with the Company, bring onto the Company's premises, use or disclose to the Company any proprietary information or trade secrets of any former employer or any other person without that person's consent.

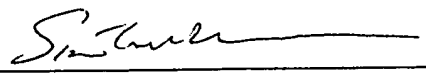
5. Miscellaneous. This is the only agreement between the Company and myself about confidential information and the ownership of inventions, and may not be modified, amended or terminated, in whole or in part, except in a writing signed by me and by an officer of the Company. I agree that, unless it is so modified, amended, or terminated, this Agreement shall be operative and binding with respect to the entire term of my employment with the Company, even if such term or employment commenced prior to the date on which I signed this Agreement. Any change in my title, compensation or duties will not affect this Agreement. This Agreement, other than the provisions which are expressly applicable only during my employment with the Company, will survive termination of my employment for any reason, and will continue for the benefit of and will be binding upon the successors, assigns, heirs and legal representatives of the Company and myself. The waiver by the Company of a breach of any of the obligations of this Agreement by me will not operate or be construed as a waiver of any other or subsequent breach by me. In the event any provision of this Agreement is held to be invalid, void or unenforceable, the remaining provisions will nevertheless continue in full force and effect without being impaired or invalidated in any way. This Agreement will be governed by the laws of the State of California governing contracts between residents to be performed in the State of Colorado.

HESKA CORPORATION

EMPLOYEE

Fred M. Schwarzer
President/CEO


Signature


Signature

COPY



HESKA

1613 Prospect Parkway
Fort Collins, CO 80525
(t) 970-493-7272
(f) 970-493-7333
www.heska.com

April 5, 2000

CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Gek-Kee Sim, Ph.D.
c/o 543 Franklin Street
Denver, Colorado 80218-3623

Dear Gek-Kee:

Enclosed please find a copy of a manuscript entitled "i

with the following authors: Shumin Yang, Karen Sellins, Tim Powell, Earl Stoneman, and Gek Kee Sim. We welcome any suggestions that you may have to this manuscript, and encourage you to send them to me. As you are aware, it is Heska's policy that all authors must read and approve the contents of any manuscripts with which they are associated. We are also sending you a copy of the Heska Technical Presentation Approval Form for you to sign. We would like to submit this manuscript as soon as possible. If we do not hear from you by April 26, 2000, we will assume that you do not wish to be an author on this paper and remove your name from it.

I hope all is well with you.

Sincerely,

Carol Talkington Verser, Ph.D.
Vice President, Intellectual Property

Encl.

Copy to: Karen Sellins, Ph.D.
Donald Wassom, Ph.D.

P 160 589 515

Manuscript

US Postal Service

Receipt for Certified Mail

No Insurance Coverage Provided.

Do not use for International Mail (See reverse)

Sent to Gek-Kee Sim, Ph.D.	
Street & Number 543 Franklin Street	
Post Office, State, & ZIP Code Denver, CO. 80218-3623	
Postage	\$ 1.21
Certified Fee	1.40
Special Delivery Fee	
Restricted Delivery Fee	2.75
Return Receipt Showing to Whom & Date Delivered	
Return Receipt Showing to Whom, Date, & Addressee's Address	1.25
TOTAL Postage & Fees	\$ 6.61
Postmark or Date	4-5-00

PS Form 3800, April 1995

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Is your RETURN ADDRESS completed on the reverse side?

SENDER:

- Complete items 1 and/or 2 for additional services.
- Complete items 3, 4a, and 4b.
- Print your name and address on the reverse of this form so that we can return this card to you.
- Attach this form to the front of the mailpiece, or on the back if space does not permit.
- Write "Return Receipt Requested" on the mailpiece below the article number.
- The Return Receipt will show to whom the article was delivered and the date delivered.

I also wish to receive the following services (for an extra fee):

1. ☒ Addressee's Address
 2. ☒ Restricted Delivery
- Consult postmaster for fee.

3. Article Addressed to:

**Gek-Kee Sim, Ph.D.
c/o 543 Franklin Street
Denver, CO. 80218-3623**

4a. Article Number

P 160 589 515

4b. Service Type

- | | |
|---|---|
| <input type="checkbox"/> Registered | <input checked="" type="checkbox"/> Certified |
| <input type="checkbox"/> Express Mail | <input type="checkbox"/> Insured |
| <input type="checkbox"/> Return Receipt for Merchandise | <input type="checkbox"/> COD |

7. Date of Delivery

4/8

5. Received By: (Print Name)

6. Signature: (Addressee or Agent)

X [Signature]

8. Addressee's Address (Only if requested and fee is paid)

PS Form 3811, December 1994

102595-97-8-0179

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HESKA TECHNICAL PRESENTATION APPROVAL FORM

TYPE OF PRESENTATION: Manuscript

IF MEETING, NAME AND DATE OF MEETING:

PRESENTATION DATE:

IF JOURNAL, NAME OF JOURNAL: Immunogenetics

SUBMISSION DEADLINE: _____

TITLE: _____

PRINCIPAL AUTHOR: Shumin Yang

OTHER CO-AUTHORS: Karen Sellins, Tim Powell, Earl Stoneman, Gek Kee Sim

Approved by:

[Signature]
Principal Author

1/16/00
Date

Karen Sellins
Co-Author

2/23/00
Date

[Signature]
Co-Author

3/17/00
Date

[Signature]
Co-Author

4/23/00
Date

Project Coordinator

Date

Chief Scientific Officer

Date

Vice President, Intellectual Property

Date

For subjects related to clinical, development, and regulatory matters:

Executive Vice President

Date

COPY

EXHIBIT B

Corres.



HESKATM

1613 Prospect Parkway
Fort Collins, CO 80525
(t) 970-493-7272
(f) 970-493-7333
www.heska.com

November 8, 2000

Via Federal Express

Gek-Kee Sim, Ph.D.
543 Franklin Street
Denver, Colorado 80218

RE: U.S. Application Serial No. 09/646,561, filed 19 September 2000, entitled
"T CELL COSTIMULATORY PROTEINS, SEQUENCES AND USES
THEREOF"
Our File No. IM-1-C1-PUS

Dear Gek-Kee:

Please find enclosed a "Declaration, Petition and Power of Attorney for Patent Application" and an "Assignment" for signature by you as an inventor of the above-referenced patent application. These documents were sent to us by Lahive & Cockfield, who is handling prosecution of this application. We would appreciate it if you would sign and date these documents and return them to us in the attached Federal Express package at your earliest convenience and, if at all possible, before December 29, 2000. If you need to make a correction to your name or address, please cross through the wrong items, print the correct information and initial the change. Also, please note that your signature needs to be notarized on the Assignment. If you have any questions, please feel free to call me. Thank you.

Sincerely,

Carol Talkington Verser, Ph.D.
Vice President, Intellectual Property and
Business Development

Encls.

JIM WOLD
HESKA CORPORATION
2601 MIDPOINT DR
FORT COLLINS
(970)493-7272

CO 80525

SHIP DATE: 08DEC00
ACC# 124028914

ACTUAL WGT: 1 LBS SCALE

TO: GEK-KEE SIM, PH.D.

543 FRANKLIN STREET

DENVER

CO 80218

4317 9072 4736

FedEx

REF:

PRIORITY OVERNIGHT MON:

CAD# 0657517 08DEC00

TRK# 4317 9072 4736 Form 0201

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11DEC00

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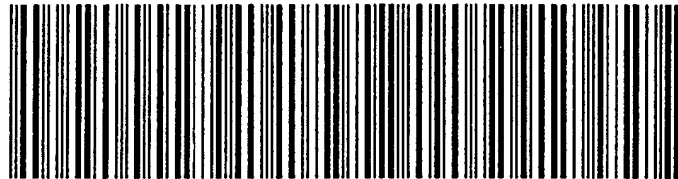


EXHIBIT C



HESKA

1613 Prospect Parkway
Fort Collins, CO 80525
(t) 970-493-7272
(f) 970-493-7333
www.heska.com

December 22, 2000

CERTIFIED MAIL NO. P160589525
RETURN RECEIPT REQUESTED

Gek-Kee Sim, Ph.D.
543 Franklin Street
Denver, Colorado 80218

RE: U.S. Patent Application Serial No. 09/646,561, filed 19 September 2000
entitled "T CELL COSTIMULATORY PROTEINS, SEQUENCES AND USES THEREOF"
Our File No. IM-1-C1-PUS (HKZ-029CPUS)

Dear Gek-Kee:

Please find enclosed the following documents for signature by you as an inventor on the above-referenced patent applications:

- a "Declaration, Petition and Power of Attorney for Patent Application" and an "Assignment" for U.S. Patent Application Serial No. 09/646,561, filed September 19, 2000; and

These documents were sent to us by outside counsel, who is handling prosecution of these applications. We would appreciate it if you would sign and date these documents and return them to us in the attached Federal Express package at your earliest convenience and, if at all possible, before December 29, 2000. If you need to make a correction to your name or address, please cross through the wrong items, print the correct information and initial the change. Also, please note that your signature needs to be notarized on the Assignment. If you have any questions, please feel free to call me. Thank you.

Sincerely,

Carol Talkington Verser

Carol Talkington Verser, Ph.D.
Vice President, Intellectual Property and
Business Development

Encls.

P 160 589 525

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Gek-Kee Sim, Ph.D.	
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543 Franklin St.	
Post Office, State, & ZIP Code	
Denver, CO 80218	
Postage	X \$
Certified Fee	X
Special Delivery Fee	
Restricted Delivery Fee	
Return Receipt Showing to Whom & Date Delivered	X
Return Receipt Showing to Whom, Date, & Addressee's Address	X
TOTAL Postage & Fees	\$
Postmark or Date	

PS Form 3800, April 1995

LM-1-C1-PUS and LM-3-C1-PCI